

REMARKS

Status of Claims

Claims 1-18 are present for examination.

Prior Art Rejection

Claims 1-4, 6-12 and 15-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshikawa (6,22,859) in view of Yahiro (6,430,178). Claims 5, 13 and 14 stand rejected under 35 U.S.C. § 103 as obvious over Yoshikawa and Yahiro and further in view of Elliott (6,690,654). The examiner further appears to take Official Notice of the equivalency between push button telephone sets and a computer terminal for use in making telephone calls. Applicant specifically traverses such taking of Official Notice and holds the PTO to strict proofs thereof. Further, claims 1-4, 6, 8-12, 15 and 16 stand rejected under 35 U.S.C. § 102 as anticipated by Lee (5,847,632). Yet further, claims 5, 13 and 14 stand rejected under 35 U.S.C. § 103 as obvious over Lee in combination with Polcyn (6,195,357) and claims 7, 17 and 18 stand rejected under 35 U.S.C. § 103 as obvious over Lee in combination with Yoshikawa.

The Examiner's rejections are respectfully traversed.

The Examiner recognizes that Yohikawa does not teach that the called and calling parties are connected for making the internet service telephone communication utilizing the same ISP network. In order to supply the missing ingredient, the Examiner turns to Yahiro and in particular the teaching in column 1, lines 27-45.

Initially, as stated in the prior reply, it is clear from Figure 3 and the description of Yohikawa that there are two internet service providers, namely, ISP-A and ISP-B. In this connection, it is noted that there is a drawing error in Figure 3 of Yohikawa inasmuch as the ISP-B is shown to include an ISP-A terminal adaptor (TA) and ISP-A server. However, according to the description in column 5, lines 30-67, Yohikawa clearly teaches two different ISPs labeled ISP-A and ISP-B and Figure 3 shows these two ISPs in the larger blocks. Thus, the Examiner's understanding of Yohikawa is consistent with that of applicant's, namely, that there is no teaching that the called and calling parties are connected for making the internet service telephone communication utilizing the same ISP network.

The general and summary discussion at column 1, lines 27-45 of Yahiro merely recognizes that communications would run more smoothly in heavy traffic conditions if the calling and called party are connected through few or a single provider. However, in the detailed discussion of Yahiro, as seen in Yahiro's Fig. 8 and the discussion beginning at column 3, line 49, it may be seen that it is the called party that sends the provider (sub-address) information to the calling party and subsequently, the calling party calls the access point of the provider suggested by the called party. In contrast, according to applicant's specifically recited claims, it is the calling party that is a subscriber to a specific ISP network and it is this same calling party that sends (via the public network) the connection point data specific to the specific ISP network to the called party and subsequent to that, it is the called party that then receives the connection point data (from the public network) and connects itself to the specific ISP according to the received connection point data. Neither Yoshikawa nor Yahiro taken singly or in combination disclose or make obvious applicant's specifically recited combination. Likewise Elliott does not supply the missing teaching lacking from Yoshikawa and Yahiro. Indeed, Elliott now appears to be cited by the examiner for a teaching of IVR relevant to dependent claims 5, 13 and 14.

With regard to the Sec. 102 rejection applying the Lee patent, it is pointed out that at column 8, line 30 of Lee it is stated that the IP enabled device 1 (the calling party) connects to "its ISP"; further at column 9, line 65 it is stated that the IP enabled device 2 (the called party) connects to "its ISP". Thus each party connects to its respective ISP. Lee does not disclose that each party connects to the "specific ISP network" as recited in applicant's claims nor does Lee disclose that the "connection point data includes the IP address in the specific ISP network and a telephone number of a point to be connected to the specific ISP network". As such Lee can not be used as an anticipatory reference against applicant's claims. In order for a reference to be utilized as an anticipatory reference under the provisions of 35 U.S.C. § 102, the reference must disclose each and every claim limitation. This is certainly not the case here, and thus the Sec. 102 rejection must be withdrawn.

Likewise the rejection as to claims 5, 13 and 14 under Sec. 103 applying Lee in combination with Polcyn and the rejection as to claims 7, 17 and 18 under Sec. 103 applying Lee in combination with Yoshikawa are defective since Lee fails to teach the important claim limitations in the main independent claims as discussed above. As a result, the PTO has not

made out a *prima facie* case of obviousness under the provisions of 35 U.S.C. § 103, and thus applicants claims are patentable over the prior art..

In view of the arguments set forth above it is submitted that the PTO has not made out a *prima facie* case of obviousness under the provisions of 35 U.S.C. § 103.

The arguments set forth above are applicable to all of applicant's independent claims. Applicant's dependent claims are deemed to be patentable at least by virtue of their dependency and are thus likewise deemed to be patentable.

Conclusions:

In view of the amendments made hereto and the arguments set forth above, it is submitted that the application is now in condition for allowance and an early indication of same is earnestly solicited.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date

11-17-05

By



FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5407
Facsimile: (202) 672-5399

David A. Blumenthal
Attorney for Applicant
Registration No. 26,257